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Daniel T. Johnson

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FAEGRE & BENSON LLP

PATENT DOCKETING

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EXAMINER

POINVIL, FRANTZY

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3692

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/883,779

Applicant(s)

JOHNSON ET AL.

Examiner

Frantzy Poinvil

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-51, 53-58 and 60-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-51, 53-58 and 60-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 3/20/08 & 11/21/07.

DETAILED ACTION

Applicant's arguments with respect to claims 49-51, 53-5 and 60-78 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 49-51, 53-58 and 60-78 are rejected under 35 U.S.C. 102(e) as being anticipated by Melby et al. (US Patent No. 6,952,680).

As per claim 49, Melby et al disclose an apparatus, system and method for tracking and managing physical assets. In so doing, Melby et al disclose a system for managing a plurality of assets of a plurality of distributed enterprises and allowing a user to access asset information, the system comprising:

a central processor accessible on a computer network (figure 3); a database for storing asset information for the plurality of assets of the plurality processor, wherein each of the plurality of assets is a piece of equipment (see the abstract), and further wherein the asset information comprises information relating to ownership, maintenance and repair of the pieces of equipment (see also the abstract). see also figure 3 and column 9, lines 27-62;

a client processor (figure 3, elements 53, 55 and 57) in communication with the central processor through the computer network, wherein the client processor inputs, queries, and downloads asset information from the central processor (column 11, lines 37-60); and

defined access levels programmed into the central processor, wherein access of the user to the asset information is determined based on the defined access levels and a user profile of the user (the different persons or administrative controllers 55 of Melby et al.), wherein the central processor tracks information relevant to managing each of the plurality of assets (column 11, lines 8-23);

wherein the access of the user to the asset information is chosen from at least one of the group consisting of access solely to asset information relating to assets at a particular site, access solely to asset information relating to assets of a particular type, access solely to asset information relating to assets for which the user has a service or maintenance contract, access solely to asset information relating to assets which are by a warranty, access solely to asset information relating to assets for which the user has a work order, access solely to asset information relating to asset costs, and access solely to asset information relating to asset usage (see column 9, lines 27-44 and column 6, lines 47-60 of Melby et al.).

As per claim 51, Melby et al disclose the system of claim 49, wherein the defined access levels are inherently determined based on at least one of user attributes and user roles and rights since there are more than one administrative controllers in most organizations and these organizations usually having a hierarchical formation of workers including a president or executive leaders, ordinary workers and or file clerk relationship.

As per claim 51, Melby et al disclose the system of claim 50, wherein the user attributes are inherently chosen from at least one of the group consisting of company of the user, position of the user in the company, and type of user since there are more than one administrative controllers in most organizations and these organizations usually having a hierarchical formation of workers including a president or executive leaders, ordinary workers and or file clerk relationship.

As per claim 53, Melby et al disclose the system of claim 49, further comprising: a database for storing service provider information the database being in communication with the central processor, and wherein the central processor is configured to automatically identify an appropriate service provider for a particular asset based on the particular asset and the service provider information, and wherein the central processor is configured to automatically alert the appropriate service provider of a service request.

As per claims 54-56, Melby et al disclose the system of claim 53, wherein the client processor is configured to automatically alert the appropriate service provider via an e-mail (column 12, lines 26-39 and column 15, lines 35-51 and column 16, lines 26-42).

As per claim 61, Melby et al teach the system of claim 49, wherein the user profile specifies sites at which the user may access asset information ((column 12, lines 26-39 and column 15, lines 35-51 and column 16, lines 26-42).

As per claim 62, in the system of Melby et al, the central processor is programmed with code for calculating a total cost of ownership (see column 13, line 5 to column 14, line 56 of Melby et al.

As per claims 64-67, these types of entities are stated throughout the specification of Melby et al.

As per claim 63, the system of claim 49, wherein the central processor is programmed with code for selectively filtering asset information based on the defined access levels and the user profile is an inherent feature since there are more than one administrative controllers in most organizations and these organizations usually having a hierarchical formation of workers including a president or executive leaders, ordinary workers and or file clerk relationship.

As per claims 68 and 69, Melby et al teach the system of claim 53, wherein the client processor is configured to receive input relating to a service need and thereby generate the service request and transmit the service request to the central processor, and the input relating to a service need is provided by a user or an asset interface. mail (column 12, lines 26-39 and column 15, lines 35-51 and column 16, lines 26-42).

As per claim 70, Melby et al disclose a system for managing a plurality of assets of a plurality of distributed enterprises at a plurality of sites and allowing a user to access asset information (see the abstract and figure 3). The system comprises: a central processor accessible on a computer network;

a database for storing service provider information and asset information for the plurality of assets of the plurality of enterprises, the database being in communication with the central processor, wherein each of the plurality of assets is a piece of equipment, and further wherein the asset information comprises information relating to ownership, maintenance and repair of the pieces of equipment (see also the abstract). see also figure 3 and column 9, lines 27-62;

a client processor in communication with the central processor through the computer network, wherein the client processor inputs, queries, and downloads asset information from the central processor; (column 11, lines 37-60) ;a first user access level programmed into the central processor, the first user access level comprising access to all of the service provider and asset information, wherein a first user type has access to the first user access level (this is an inherent feature as the system of Melby et al includes a plurality of asset controllers and/or entities having specific functions);

a second user access level programmed into the central processor, the second user access level comprising access to the service provider information and the asset information for predetermined sites, wherein a second user type has access to the second user access level (this is an inherent feature as the system of Melby et al includes a plurality of asset controllers and/or entities having specific functions);

identification software associated with the central processor, the identification software configured to automatically identify an appropriate service provider for a particular asset based on the particular asset and the service provider information and notification software associated with the central processor, the notification software configured to automatically alert the

appropriate service provider of a service request mail (column 12, lines 26-39 and column 15, lines 35-51 and column 16, lines 26-42).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 57-60 and 71-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melby et al. (US Patent No. 6,592,680).

As per claims 57-60, Melby et al disclose alerting a service provider for maintenance. See column 10, lines 11-50. Melby et al do not explicitly state the client processor is further configured to automatically transmit a second alert to the appropriate service provider after a predetermined period of time or the system of claim 53, wherein the client process is further configured to automatically transmit a second alert to another service provider after a predetermined period of time or the system of claim 57, wherein the client processor is further configured to automatically transmit a third alert to the appropriate service provider after a second predetermined period of time. As per these features, the Examiner asserts that these are obvious business decisions to make by an organization in order to look as quickly as possible for an appropriate service provider capable of servicing needed repair and/or maintenance so as to avoid possible delays in their routine business activities.

As per claims 71-78, the system of Melby et al are discussed above. The system also includes a plurality of workers, operators and types of entities having access to the one or more types of assets. Providing a third user access level programmed into the central processor, the third user access level comprising access to the asset information for predetermined assets, wherein a third user type has access to the third user access level; and the appropriate service provider is a third user type, and the first user type has full rights to operate the system; wherein the second user type has rights to add or modify any asset information relating to the assets at the predetermined sites and further has rights to submit work orders relating to the assets at the predetermined sites; wherein the third user type has rights to add or modify any asset information relating to the predetermined assets, wherein the third user type is a manufacturer and further wherein the predetermined assets are all assets manufactured by the manufacturer; wherein a user is determined to be one of the first user type or the second user type based on the hierarchical enterprise status of the user, and wherein a user is determined to be one of the first user type, the second user type, or the third user type based on the hierarchical enterprise status of the user would have been obvious to one of ordinary skill in the art in order to set limited access to the different entities on records of the types of assets for security and or privacy purposes.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Frantzy Poinvil/
Primary Examiner
Art Unit 3692**

March 19, 2008